

**REMARKS**

This amendment is filed in response to the final rejection Action dated January 30, 2004. This amendment should be entered, the application allowed, and the case passed to issue.

This amendment should be entered as no new matter or considerations are introduced by this amendment. Claims 1 and 2 are amended in response to the indefiniteness rejections under 35 U.S.C. § 112. The amendment to claim 1 is supported by claims 4 and 5, and the description of Figure 4 on page 5, lines 9-12, of the specification.

Claims 1, 2, and 6 are pending in this application. Claims 3-5 have been cancelled. Claims 1, 2, and 6 are rejected.

***Claim Rejections Under 35 U.S.C. § 112***

Claims 1, 2, 4, and 6 are rejected under 35 U.S.C. § 112, second paragraph, as being indefinite. This rejection is traversed, and reconsideration and withdrawal thereof respectfully requested.

The Examiner asserts that it is not clear what is the form, structure, and chemistry of the filter cloth, and how the middle layers are bonded to protective layers in claim 1. The Examiner further asserts that it is not clear what the protective layers of claim 2 are and how they are bonded to the middle layer. As regards claim 5, the Examiner avers that it is not clear how the protective layers and batt fibre layers are bonded to the middle layer. In addition, it is not clear to the Examiner how the structure of the filter cloth is related to the air permeance.

Applicants submit that the instant claims fully comport with the requirements of 35 U.S.C. § 112. As recited in claim 1, “the middle layer has a woven structure comprising machine direction threads and transverse threads.” The woven structure is clearly described in the specification and is illustrated in Fig. 4. Claim 1 also recites that, “the protective layers are batt fibre layers attached to the middle layer by needling.” The specification clearly discloses the chemical make up of the filter cloth (page 5, line 10 to page 6, line 13; and page 7, lines 21 to 28).

As regards claims 2 and 5, the specification and claims clearly describe the protective layers and how the protective layers and batt fibre layers are bonded to the middle layer, as explained above.

As regards claim 6, the specification (page 6, line 29 to page 7, line 15) clearly describes the claimed air permeance. In addition, in view of amendment to claim 1 and the above remarks regarding the structure of the filter cloth, the recited air permeance in claim 6 is not indefinite.

Applicants submit that each ground of rejection under 35 U.S.C. § 112, second paragraph, has been thoroughly addressed and overcome. Therefore, the indefiniteness rejections should be reconsidered and withdrawn.

***Claim Rejections Under 35 U.S.C. § 102***

Claims 1, 2, 4, and 5 are rejected under 35 U.S.C. § 102(b) as being anticipated by SU 172 4321. This rejection is traversed, and reconsideration and withdrawal thereof respectfully requested. The following is a comparison between the invention as claimed and the cited prior art.

An aspect of the invention, per claim 1, is a solid-liquid filtration filter cloth which is intended for use in a pressure filter based on diaphragm extrusion which comprises at least two filter chambers. The filter cloth is guided through the filter chambers arranged one after the other in the direction of movement of the filter cloth so that in the filter chambers the opposite sides of the filter cloth are alternately against the slurry to be filtered. The slurry contains liquid and solids. The filter cloth is symmetrical in respect of the filtering ability. The filter cloth comprises a middle layer. Both surfaces of the middle layer are provided with protective layers which form the outer surfaces of the filter cloth and are denser than the middle layer. The protective layers are batt fibre layers attached to the middle layer by needling. The middle layer has a woven structure comprising machine direction threads and transverse threads and withstanding tensile stress thus allowing the solids separated from the slurry in the filter to be conveyed out of the filter chambers by means of the filter cloth.

The Examiner asserts that SU `321 describes a woven or non-woven cloth which has utility in multilayer filtering. The Examiner avers that the cloth has an intermediate framework with face and reverse layers joined together by needling and made of synthetic fibers.

SU `321 does not anticipate the instant claims. The Examiner's rejection was based on the abstract of SU `321. For the Examiner's convenience, a translation of SU `321 is attached to this response.

SU `321 discloses a multilayered filter material for the cleaning of gases. The filter material comprises a face layer 1, a reverse layer 2, and an additional layer 3 between the face layer 1 and reverse layer 2. As explained on page 3, lines 7-14, a

framework layer 4 is placed in the additional layer 3. Further, claim 1 of SU '321 discloses that the framework layer is placed in the additional layer at a distance from the outer surfaces of the face and reverse layers. Therefore, SU '321 does not disclose a filter cloth comprising a middle layer the both surfaces of which are provided with protective layers, as required by Applicants' claim 1.

SU '321 is further distinguishable over the instant invention because the face and reverse layers of SU '321 are not denser than the framework layer. Claim 1 of the present invention requires that the protective layers are denser than the middle layer. SU '321 discloses that the outer layers of the gas filter are less dense than the additional layer and further that the additional layer is less dense than the framework layer, which is the most dense part of the SU '321 filter (page 4, lines 7-24). Furthermore, Example 3 of SU '321 discloses that the surface density of the face and reverse layers is  $60 \text{ g/m}^2$  and the surface density of the additional layer is  $167 \text{ g/m}^2$ . In addition, claim 1 of SU '321 discloses that the density of the needle piercing of the additional layer is two times higher than that of the face layer and the reverse layer.

Furthermore, SU '321 is distinguishable over the present invention because Applicants' claim 1 requires that the filter cloth is symmetrical in respect of the filtering ability. On the contrary, SU '321 discloses placing the framework into the additional layer in different positions (page 4, lines 3-6). SU '321 does not disclose that the filter cloth is symmetrical in respect of the filtering ability as required by claim 1.

The factual determination of lack of novelty under 35 U.S.C. § 102 requires the disclosure in a single reference of each element of a claimed invention. *Helifix Ltd. v. Blok-Lok Ltd.*, 208 F.3d 1339, 54 USPQ2d 1299 (Fed. Cir. 2000); *Electro Medical*

*Systems S.A. v. Cooper Life Sciences, Inc.*, 34 F.3d 1048, 32 USPQ2d 1017 (Fed. Cir. 1994); *Hoover Group, Inc. v. Custom Metalcraft, Inc.*, 66 F.3d 399, 36 USPQ2d 1101 (Fed. Cir. 1995); *Minnesota Mining & Manufacturing Co. v. Johnson & Johnson Orthopaedics, Inc.*, 976 F.2d 1559, 24 USPQ2d 1321 (Fed. Cir. 1992); *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051 (Fed. Cir. 1987). Because SU '321 does not disclose a filter cloth comprising a middle layer the both surfaces of which are provided with protective layers, protective layers that are denser than the middle layer, and that the filter cloth is symmetrical in respect of the filtering ability, as required by claim 1, SU '321 does not anticipate claim 1.

***Claim Rejections Under 35 U.S.C. § 103***

Claims 1 and 6 are rejected under 35 U.S.C. § 103(a) as being unpatentable over SU '321. This rejection is traversed, and reconsideration and withdrawal thereof respectfully requested.

The Examiner concludes that it would have been obvious to one of ordinary skill in this art to optimize the air permeance factor so that air permeance would improve the properties of the filter cloth. As regards claim 6, the Examiner acknowledges that SU '321 is silent about the permeance factor.

Claims 1 and 6 are not obvious for at least the reasons discussed above. SU '321 does not suggest the claimed middle layer provided with the protective layers, the relative density of the protective layers and the middle layers, and filtering ability symmetry.

Obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either explicitly or implicitly in the references themselves or

in the knowledge readily available to one of ordinary skill in the art. *In re Kotzab*, 217 F.3d 1365, 1370 55 USPQ2d 1313, 1317 (Fed. Cir. 2000); *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988); *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). There is no suggestion in SU '321 to modify the filter cloth so that it comprises a middle layer the both surfaces of which are provided with protective layers, outer layers which are denser than the middle layer, and be symmetrical in respect of the filtering ability, as required by claim 1. There is also no suggestion in SU '321 to modify the filter cloth to have the air permeance, as required by claim 6.

The requisite motivation to support the ultimate legal conclusion of obviousness under 35 U.S.C. § 103 is not an abstract concept, but must stem from the applied prior art as a whole and realistically impel one having ordinary skill in the art to modify a specific reference in a specific manner to arrive at a specifically claimed invention. *In re Deuel*, 51 F.3d 1552, 34 USPQ2d 1210 (Fed. Cir. 1995); *In re Newell*, 891 F.2d 899, 13 USPQ2d 1248 (Fed. Cir. 1989). Accordingly, the Examiner is charged with the initial burden of identifying a source in the applied prior art for the requisite realistic motivation. *Smiths Industries Medical System v. Vital Signs, Inc.*, 183 F.3d 1347, 51 USPQ2d 1415 (Fed. Cir. 1999); *In re Mayne*, 104 F.3d 1339, 41 USPQ2d 1449 (Fed. Cir. 1997). There is no motivation in SU '321 to modify the filter cloth so that it comprises a middle layer the both surfaces of which are provided with protective layers, outer layers which are denser than the middle layer, and be symmetrical in respect of the filtering ability, as required by claim 1. There is also no motivation in SU '321 to modify the filter cloth to have the air permeance, as required by claim 6.

The only teaching of the claimed solid-liquid filtration filter cloth is found in Applicants' disclosure. However, the teaching or suggestion to make a claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on applicant's disclosure. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991). The motivation for modifying the prior art must come from the prior art and must be based on facts.

In light of the Amendments and Remarks above, this amendment should be entered and the application allowed. If there are any questions regarding this amendment or the application in general, a telephone call to the undersigned would be appreciated to expedite the prosecution of the application.

To the extent necessary, a petition for an extension of time under 37 C.F.R. § 1.136 is hereby made. Please charge any shortage in fees due in connection with the filing of this paper, including extension of time fees, to Deposit Account 500417 and please credit any excess fees to such deposit account.

Respectfully submitted,

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